

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 004770.00891)

In re U.S. Patent Application of Toni Kopra)
Application No. 09/580,583) Group Art Unit: 3622
Filed: May 30, 2000) Examiner: Retta, Yehdega
For: LOCATION AWARE PRODUCT) Confirmation No. 8331
PLACEMENT AND ADVERTISING)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-14501

Sir:

Applicant respectfully requests review of the final rejections in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal and a one-month extension of time. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

Remarks

Having received and reviewed the Final Office Action of February 2, 2009, Applicant submits that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005. Reconsideration and allowance of the instant application is respectfully requested in view of the remarks presented in this response. Claims 19, 22-34, 41, 45-57 and 49-53 are pending in this application.

The specific errors relied upon in this Request for Review include the following:

- The pending 35 U.S.C. §103 rejections fail to address all the claim limitations.

A. Claim Rejection Under 35 USC §103 of Claims 19, 22-24, 28, 29, 34, 41 and 50-53

Claims 19, 22-24, 28, 29, 34, 41 and 50-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rangan et al. U.S. Patent No. 6,006,265 in view of Applicant's background further in view of Bandera et al. U.S. 6,332,127 and further in view of Owa et al. (US 6,711,379 B1).

Applicants have reviewed the Office Action and respectfully traverse. Claim 19 recites, *inter alia*, wherein the mobile communication network is a different network than the digital broadcasting network. The Office Action alleges that a combination of Rangan and AAPA discloses a digital broadcasting network, Bandera discloses a mobile communication network, and Owa discloses both a digital broadcasting network and a mobile communication network. However, neither reference discusses a mobile communication network that is a different network than the digital broadcasting network, where the mobile communications network is used to determine the location of the mobile terminal and to receive content related to the link.

The Office Action admits that Rangan, AAPA, and Bandera, alone or in combination, fail to provide wherein the mobile communication network is a different network than the digital broadcasting network. *See* Office Action, p. 4. As a result, it cites to Owa to purportedly fill that deficiency. However, Owa fails to teach a mobile communications network as claimed. The mobile communications network of claim 19: (1) is different than the digital broadcasting network, (2) is used to determine the location of the mobile terminal, and (3) receives content related to the link. The network of Owa cited by the Office Action is a global positioning satellite system that can determine the location of a mobile terminal, but does not receive content related to the link. The GPS receiver and network in Owa is capable of performing one and only one task, i.e., of determining the location of the mobile terminal. GPS as disclosed in Owa is incapable of transmitting content related to the link. The Office Action even admits that “Global positioning system is not capable of transmitting the digital signal.” *See* Office Action, p. 5. As such, Owa does not disclose a “mobile communications network” as claimed in claim 19, and fails to remedy the deficiencies in the combination rejection.

In summary, Rangan (or a combination of Rangan and AAPA) fails to disclose the feature of wherein the mobile communication network is a different network than the digital broadcasting network as recited in claim 19. The system of Rangan is fully performed by one network. Moreover, Bandera fails to cure the deficiency of Rangan and the AAPA (i.e., Bandera fails to teach or suggest multiple networks, let alone the features of claim 19.) Bandera’s network is compatible

with Rangan/AAPA's alleged 3G network and without more, it would not have been obvious to one skilled in the art to introduce a second, different network, much less performing the method of claim 19 over two networks, wherein the mobile communication network is a different network than the digital broadcasting network. As such, claim 19 is distinguishable from any combination of Rangan, AAPA, Bandera, and Owa. Applicants respectfully request withdrawal of the rejection and allowance of claim 19.

Independent claims 28, 34, 41, 50, 52, and 53 recite features similar to those discussed above with respect to claim 19 and are allowable for at least the same reasons as claim 19.

Claims 22-24, 29, 45-47, 49, and 51 ultimately depend on claims 19, 28, 34, 41 and 50 and are allowable for at least the same reasons as their base claims and in further view of the advantageous features recited therein.

B. Claim Rejection Under 35 USC §103 of Claims 25-27 and 30-33

Claims 25-27 and 30-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rangan in view of AAPA further in view of Bandera further in view of Owa and futher in view of U.S. Patent No. 6,198,935 to Saha et al. ("Saha").

Applicant respectfully traverses. Claims 25-27 and 30-33 ultimately depend on claims 19 and 28. Saha fails to cure the deficiency of Rangan, AAPA, and Bandera with respect to claims 19 and 28. As such, claims 25-27 and 30-33 are allowable for at least the same reasons as the claims from which they depend and in further view of their advantageous features recited therein.

CONCLUSION

While Applicant believes the above points represent the clearest errors made by the Office, Applicant reserves the right to appeal on other bases and errors should the appeal of this case proceed after the Office's consideration of this paper. All issues having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (312) 463-5000.

Respectfully submitted,

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